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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,439	06/03/2005	Roger P Reid	3841	7462

27727 7590 12/14/2006  
PEDERSEN & COMPANY, PLLC  
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BOISE, ID 83701

EXAMINER.

KIM, SUN U

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/509,439	REID ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	John Kim	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/3/05</u> .  | 6) <input type="checkbox"/> Other: _____                          |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-30, drawn to fluid treatment media, classified in class 210, subclass 502.1.
  - II. Claims 31-39, drawn to method of making fluid treatment media, classified in class 264, subclass 122.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a binder material that does not require heating.

3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the

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inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Ken Pedersen on 12/8/06 a provisional election was made without traverse to prosecute the invention of Group II, claims 31-39. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Examiner suggests applicants to include in the first page of the specification, a benefit of priority to PCT/US03/08755 filed 3/24/03 which claims benefit of 60/367,028 filed 3/23/02.

7. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Appropriate correction is required.

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8. Claims 36-37 are objected to because of the following informalities: A symbol "<" in claims 36-37 should be written out as "less than". Appropriate correction is required.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 33-34 and 37-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Recitations of "the primary material" in claims 33-34 and 37 and "said active particles" in claim 38 lack a positive antecedent basis.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 31, 33-36 and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Kelly et al (US Patent No. 6,793,866 B2).

Regarding claims 31 and 33-34, Kelly et al teach a method of making a fluid treatment media comprising mixing together only binder material and activated carbon which are sorbent materials, heating the resulting mixture to a temperature of 3 to 30 degree C above the crystalline melting point of the polyolefin binder wherein a melting point of LDPE powder is approximately 110 degree C; therefore, 30 degrees C above the melting point of LDPE powder is 140 degrees C which is 284 degrees F which is within the claimed range and wherein at such

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temperature, the polyolefin binder material softens for activated carbon to adhere to the binder material, cooling the mixture wherein no solid support material is included in the mixture (see col. 2, lines 21-38; col. 3, line 31 –41; col. 5, line 55 – col. 6, line 4; col. 8, lines 40-55; col. 10, line 57 – col. 11, line 15).

Regarding claim 35, Kelly et al teach polyolefin binder material having crystalline melting points from 50 to 200 degree C (see col. 4, lines 23-33). However, Kelly et al is silent on Vicat softening point of the polyolefin binder material. As an evidence of the Vicat softening point of polyolefin binder material, Lisenko '550 (US Patent No. 5,639,550) teaches that typical binder material including polyolefin has a Vicat softening temperature of about 250 degree F to about 400 degree F (see col. 4, lines 7-33).

Regarding claim 36, Kelly et al teach that binder particles size is between 5 and 125 microns which are less than 150 microns (see col. 2, lines 20-28).

Regarding claim 38, Kelly et al teach fluid treatment media comprising a mixture of 80 weight % of activated carbon and 20 weight % of polyethylene binder powder (see samples A-E of Table in col. 11-12).

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 32, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. Kelly et al teach a method of making a fluid treatment media as described in above paragraph 12.

Regarding claim 32, Kelly et al further teaches that polyolefin binder powders have melt indexes from fractional to 1000 g/10 min (see col. 4, lines 23-31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to discover optimal range of polyolefin binder material of 1-10 g/min, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Regarding claim 37, Kelly et al further teaches that activated carbon particles has an average particle size of 12 to 325 mesh which are 44 to 1680 microns (see col. 3, lines 49-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to discover optimal diameter of activated carbon less than 150 microns, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Regarding claim 39, Kelly et al teach that polyolefin binder particles are less than 150 microns (see col. 2, lines 20-28) and activated carbon particles has an average particle size of 12 to 325 mesh which are 44 to 1680 microns (see col. 3, lines 49-51). It would have been obvious

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to one having ordinary skill in the art at the time the invention was made to discover optimal particle size of binder material and activated carbon to be less than 150 microns, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

15. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

16. Claims 31-39 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 31-39 of copending Application No. 10/396,296. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent No. 4,753,728 teaches polyolefin binder material with low melt index.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kim whose telephone number is 571-272-1142. The examiner can normally be reached on Monday-Friday 7 a.m. - 3:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**John Kim**  
**Primary Examiner**  
**Art Unit 1723**

JK

December 11, 2006